

Docket No.: 3273-0214PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kuniharu HARADA et al.

Conf.: 7685

Application No.: 10/549,706

Art Unit: 1796

Filed: September 19, 2005

Examiner: R. A. SERGENT

For: AQUEOUS SILYLATED URETHANE
COMPOSITIONS, AQUEOUS ADHESIVES
FOR WRAPPING, AND AQUEOUS
CONTACT ADHESIVES

PETITION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition from a purported “restriction requirement” allegedly made in the Office Action of January 4, 2009.

This application was filed with claims 1-15 drawn to water-based silylated urethane compositions which have adhesive properties. In an Amendment filed September 30, 2008, the claims were limited to particular methods of using those compositions.

On January 4, 2009, the PTO issued a communication which indicated, among other things, that “The examined composition claims and the newly amended methods of using claims are subject to restriction.” However, no restriction requirement has yet been made between any allegedly distinct inventions described in the present application.

Applicants traversed the (lack of a) restriction requirement in an Amendment filed on January 29, 2009. In the Office Action of May 11, 2009, the PTO reiterated that claims in this application were “subject to restriction.”

MPEP 817 expressly directs that “The following outline should be used to set forth a requirement to restrict.

OUTLINE OF RESTRICTION REQUIREMENT

(A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121.

(1) Identify each group by Roman numeral.

(2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.

(4) Classify each group.”

Applicants respectfully request that – if the PTO wishes to persist in requiring restriction in the present application – a clear and detailed record of the restriction requirement be set forth, in order to prove a clear demarcation between restricted inventions, so that it can be determined whether inventions claimed in a continuation application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 U.S.C. 121. See MPEP 814.

Contact information

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No.

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28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated:

AUG 11 2009

Respectfully submitted,

By 

Gerald M. Murphy, Jr.

Registration No.: 28,977

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